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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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| RE APPLICATION OF | : |
| GENE EGGLESTON, ET AL. | : EXAMINER: WINDER, PATRICE |
| SERIAL NO: 09/095,325 | : |
| FILED: JUNE 10, 1998 | : GROUP ART UNIT: 2152 |
| FOR: MOTOROLA V. RESEARCH IN MOTION--METHOD AND APPARATUS FOR RATE GOVERNING COMMUNICATIONS | : |

37 CFR 1.131 DECLARATION OF GENE EGGLESTON

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

(1) I am a co-inventor of the above-identified application. My co-inventors were Mitch Hansen and Richard Krebs.

(2) I am currently employed by Motorola, the assignee of the application, and hold the position of Director, Technology Licensing.

(3) In December of 1995, I was also an employee of Motorola and held the position of Manager, Partnership Programs.

(4) I have reviewed claims 33-65 of the application. In particular I have reviewed independent claims 33, 54, 55, 56, 60, 64, and 65. Each of those claims recites what I refer to as the transparency feature. For example, claim 33 recites:

33. A method of forwarding messages between a host system and a mobile client, comprising the steps of:

establishing a session based on loaded parameters at the host system;

maintaining the session at the host system and querying the host system;

receiving messages directed to a first address at the host system from a plurality of message senders;

in response to a query, continuously forwarding the messages from the host system to the mobile client;

receiving the messages at the mobile client;

generating reply messages at the mobile client to be sent to the plurality of message senders and transmitting the reply messages to the host system;

**receiving the reply messages at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system**; and

transmitting the reply messages from the host system to the plurality of message senders.

(5) Prior to June 07, 1995, we had completed in this country our invention as described and claimed in the subject application as evidenced by the following paragraph.

(6) Prior to June 07, 1995, having earlier conceived of the claimed invention including the transparency feature, Motorola prepared on my behalf electronic "Help" documents regarding a mobile device and a server running thereon including software embodying the transparency feature of the invention. The "Help" documents included the attached CCBKGRND.HLP documents, Exhibits A - C.

- Exhibit A ("Running and Using Motorola AirMobile for cc:Mail") reflects that messages from a user's LAN-based inbox were passed from that inbox to an in-box of the mobile device (i.e., the cc:Mail Mobile inbox). Likewise, messages from the mobile device's outbox were uploaded to the user's LAN-based mail server for delivery.

- Exhibit B ("Launching Motorola AirMobile Wireless Client for cc:Mail") reflects that, in order to download and upload messages from the LAN-based mail server, the mobile device was required to register with a Communication Server. See steps 1-3 of the Prerequisites. Once registered, the mobile device was able to send and receive e-mail messages via the Communication server. See the last two steps of Exhibit B.

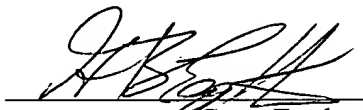
- Exhibit C ("General Information") reflects that a user name and a remote radio were associated with a user. See Figure x-x. Comparing the Remote Radio ID of user Mitch Hansen illustrated in Exhibit C and the example of the sending and transmitting example 4 shown in Exhibit B, one sees that the Remote Radio ID was used by the system in order to transmit messages to and from the Communication server. However, the Radio ID is not reflected in the user's email address and hence is transparent.

(7) In addition to the "Help" documents addressed above, I also recall using the invention at a tradeshow before June 07, 1995. During the trade show I used the mobile device to send and receive emails from a first mobile device to a second mobile device via a communication server. The Radio ID's of the respective mobile devices were not reflected in the headers of the email messages. Instead, the email addresses identifying the respective user's inbox was identified in the header.

(8) In signing this declaration, I recognize that the declaration may be filed as evidence in a contested case before the Board of Patent Appeals and Interference of the United States Patent and Trademark Office. I also recognize that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross

examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

(9) I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.



Gene Eggleston

11/9/06

Date

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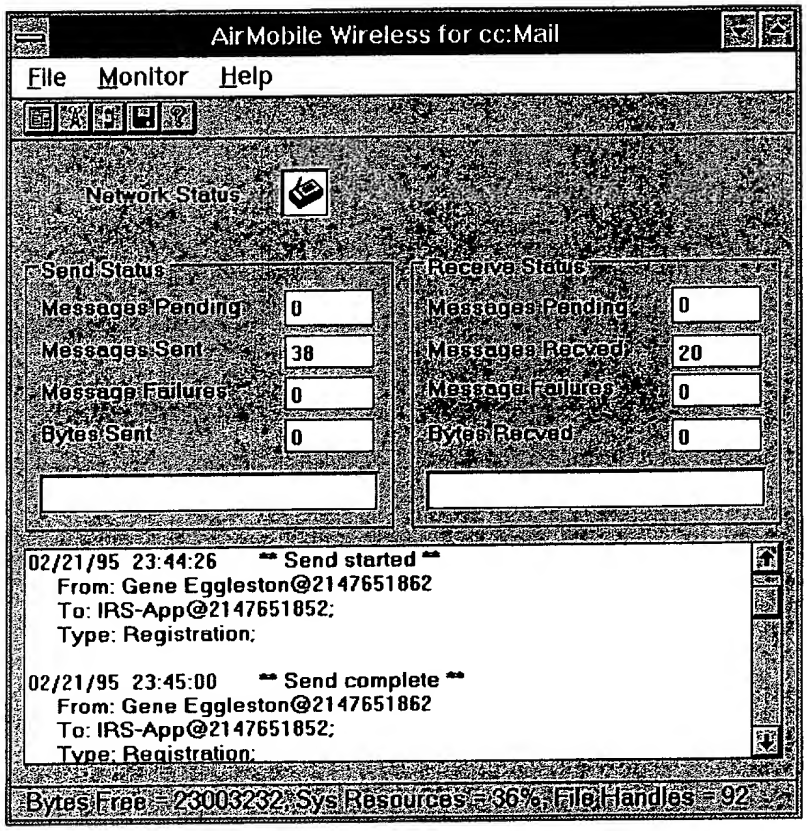
# Running and Using Motorola AirMobile for cc:Mail

This section describes how to run Motorla Air*Mobile* Wireless Client for cc:Mail and defines the user interface.

The "AirMobile Wireless Client for cc:Mail" dialog menu below contains "hot spots" which define each attribute on the menu. To obtain information pertaining any button, field, etc, move your mouse over item on the dialog menu below, when the mouse turns into a "pointing hand" click the mouse to display a definition for that item.




## Overview

Motorola's Air*Mobile* Wireless Client for cc:Mail operates much like Lotus' cc:Backgrounder. It downloads messages, which pass your download filters, from your LAN-based inbox to your cc:Mail Mobile inbox. It also uploads messages from cc:Mail Mobile's Outbox to your LAN-based mail server for delivery.

Motorolas Air Mobile Wireless Client for cc:Mail is a complimentary addition to your cc:Mail Mobile program. It brings new wireless communication capabilities to cc:Mail Mobile which were previously not possible, while not disrupting or preventing use of any existing cc:Mail Mobile communication method.

While Motorola's Air*Mobile* Wireless Client for cc:Mail can be compared to Lotus' cc:Backgrounder in many fundamental ways, there are also several key differences, some of which will change your whole perspective of the mobile e-mail model. These key differences are explained below.

1. Always connected but no connection time costs

   Motorola Air*Mobile* Wireless Client for cc:Mail establishes and maintains a secure and

authenticated wireless connection between your cc:Mail Mobile account on your laptop and your LAN-based cc:Mail server. This connection enables messages to be immediately downloaded when they are received or immediately uploaded when they are sent. This eliminates the batch mode of operation cc:Backgrounder has typically used.

2. Messaging models: client poll and server push

   Motorola Air*Mobile* Wireless Client for cc:Mail implements both the traditional e-mail client poll and the more efficient server push models of message delivery. cc:Backgrounder implements the client poll model only. Motorolas implementation of server push eliminates unnecessary communication between the client and server, minimizing communication costs and artificial delivery delays.

   When you send a message while Motorola Air*Mobile* is running, the message will be immediately processed from your outbox, assuming it passes your upload filters, and delivered to your LAN-based cc:Mail server for ultimate delivery.

   When a message arrives for you in your LAN-based cc:Mail Inbox, Motorola Air*Mobile* will immediately download the message to your laptop, assuming it passes your download filters, placing it in your cc:Mail Mobile Inbox.

3. Server based filters for downloads

   Motorola Air*Mobile* maintains a copy of the filter settings defined by you via your client software on the Motorola Air*Mobile* Communication Server for cc:Mail. All filter changes made via your client software will be propagated to your registered account on your Motorola Air*Mobile* Communication Server for cc:Mail.

   These server-based filters for each user define the criteria which must be satisfied before a message will be pushed to a registered client.

   By contrast, cc:Backgrounder does not support server-based filtering nor does it support server-push message handling.

4. Client based filters for uploads

   Motorola Air*Mobile* uses several of the key filter settings defined by you as upload filters which control how the messages you send are uploaded from your cc:Mail Mobile Outbox. Messages which pass your upload filters will be uploaded via Motorola Air*Mobile*. Messages which do not pass your upload filters will remain in your Outbox waiting to be sent via another communication method (e.g., Direct LAN connection) or the clients filters are changed. Upload filters are message: priority, size and date.

   cc:Backgrounder does not apply any filters to the upload its process.

5. Granularity filtering for message download

   Motorola Air*Mobile* provides the user the ability to download only specific portions of messages which do not pass all other filter criteria. This enables a user to receive the portion of a message which is most valuable to them; the first part of a text message, a file attachment or text notes.

6. User Interface

   The Motorola Air*Mobile* user interface has been designed to summarize the number of messages sent and received, the current state of communications and a log window documenting all major events.

## Launching Motorola Air*Mobile* Wireless Client for cc:Mail

Motorola Air*Mobile* Wireless Client for cc:Mail can be launched automatically by cc:Mail Mobile or directly from the Windows Program Manager.

**Auto-Launch via cc:Mail Mobile**
Motorola Air*Mobile* Wireless Client for cc:Mail will automatically launch when cc:Mail Mobile is launched if you have defined Motorola Air*Mobile* Wireless as your default *Location Setup* .

**Manual Launch via cc:Mail Mobile**
If Motorola Air*Mobile* Wireless Client is not already running, it will be automatically launched when you change the *Location Setup* within cc:Mail Mobile.

**Manual Launch from Windows**
Motorola Air*Mobile* Wireless Client for cc:Mail can be manually launched from Windows by simply double-clicking on the Air*Mobile* Backgrounder Icon.

## Communicating between Client and Communication Server

**Prerequisites**
To send or receive messages via Motorola Air*Mobile* Wireless Client for cc:Mail you or your e-mail administrator must have installed and configured both cc:Mail Mobile for Windows Release 2 and Motorola Air*Mobile* Wireless Client for cc:Mail. See sections 2 and 3 of this manual for instructions on installing and configuring Motorola Air*Mobile* Wireless Client for cc:Mail.

In addition, you or your LAN administrator must have installed and configured a cc:Mail e-mail server and a Motorola Air*Mobile* Wireless Communication Server for cc:Mail.

1. **Launch Motorola Air*Mobile* Client for cc:Mail**

   a) When first launched, the Motorola Air*Mobile* logo is displayed for approximately 5 seconds then disappears displaying the Air*Mobile* Wireless for cc:Mail Main Menu

   b) Your cursor will change to an "hour glass" shape while Air*Mobile* initializes your communication port and while verifying you are within network coverage.

   During the initialization, the "network status indicator has a red slash through it  signifying your wireless network connection is not active. After initialization the communications port and determination that the wireless network is accessible, the red slash disappears  .

   If the initialization fails or the wireless network is not accessible, the red slash will continue to be displayed, even after the "hour glass" mouse returns to a pointer.

2. **Verify a successful registration was sent**

   Upon successful launch and initialization (step 1, above), the Air*Mobile* Wireless Client for cc:Mail will send a registration request to the Air*Mobile* Wireless Communication Server whose address is defined in the "Remote Radio ID" field in your profiler configuration utility.

   Below is an example of a successful "registration send" transaction.

```
2/15/95 10:15       *** SEND STARTED ***
       From: Mitch Hansen@15001455
       To: IRS-App@15001456
       Type: Registration

2/15/95 10:16       *** SEND COMPLETED ***
       From: Mitch Hansen@15001455
       To: IRS-App@15001456
       Type: Registration
```

Note: If a registration send is not confirmed within 5 minutes from a *send completed* the client will submit another registration request.

3. **Verify a successful registration was received.**

   Upon successful send of a registration request (step 2, above), the Air*Mobile* Wireless Communication Server sends a registration confirmation back to your client. The return of the registration confirms that you successfully sent a message to the Communication Server, your cc:Mail password was correct and your cc:Mail postoffice was on-line.

   Upon the successful receive of a registration transaction, your client becomes fully registered. Once fully registered your client may send messages, send profile change transactions or simply listen to the network for messages to be "pushed" to your client by the Communication Server.

   Below is an example of a successful "registration receive" transaction.

```
2/15/95 10:15       *** RECEIVE STARTED ***
       Type: Unknown; Host: Unknown;

2/15/95 10:16       *** RECEIVE COMPLETED ***
       From: IRS-App@15001456
       To: Mitch Hansen@15001455
       Type: Registration
```

   Note: If your client is inactive ( not having sent or received messages) for 20 minutes, your client will automatically re-register with the Communication Server.

4. **Sending/Transmitting e-mail messages.**

   Sending a message is the same as always. Simply use cc:Mail Mobile to send messages which will be stored in the Outbox. Once you are registered (steps 2 & 3 above) the Client software will automatically transfer messages which pass your upload filters to your Communication Server. Eliminating the need to find a phone and manually issue a SEND/RECEIVE command.

   Below is an example of a successful "message send" transaction.

```
2/15/95 10:19       *** SEND STARTED ***
       From: Mitch Hansen@15001455;
       To: Gene Eggleston@15001456;
       Subject: Important Meeting;
       Type: ccMail Msg; MsgID: 1901;

2/15/95 10:20       *** SEND COMPLETED ***
       From: Mitch Hansen@15001455;
       To: Gene Eggleston@15001456; .
       Subject: Important Meeting;
```

```
      Type: ccMail Msg; MsgID: 1901;
```

**4. Receiving e-mail messages.**

Receiving mail messages is easier than ever, once you are registered (steps 2 & 3 above) the Client software will automatically receive messages, which pass your download filters, from the Communication Server.

Below is an example of a successful "message receive" transaction.

```
2/15/95 10:20      *** RECEIVE STARTED ***
      From: Mitch Hansen@15001455;
      To: Gene Eggleston@15001456;
      Subject: Important Meeting;
      Type: ccMail Msg; MsgID: 1901;

2/15/95 10:21      *** RECEIVE COMPLETED ***
      From: Mitch Hansen@15001455;
      To: Gene Eggleston@15001456;
      Subject: Important Meeting;
      Type: ccMail Msg; MsgID: 1901;
```

## General Information

Follow the instructions in this section to configure Motorola Air*Mobile* Wireless for cc:Mail.

1. Launch Profiler.

   In Windows, double-click the AirMobile Wireless for cc:Mail Profile icon 

   or choose the "Profiler" tool  from the "AirMobile Wireless Client for cc:Mail" tool bar.

   When launched for the first time, the AirMobile Profiler will automatically build a database to retain essential information. Click OK to continue. A blank user profile screen is displayed (Figure x-x).

2. The "General Information" dialog menu below contains "hot spots" which define each attribute on the menu. To obtain information pertaining any button, field, etc, move your mouse over item on the dialog menu below, when the mouse turns into a "pointing hand" click the mouse to display a definition for that item.

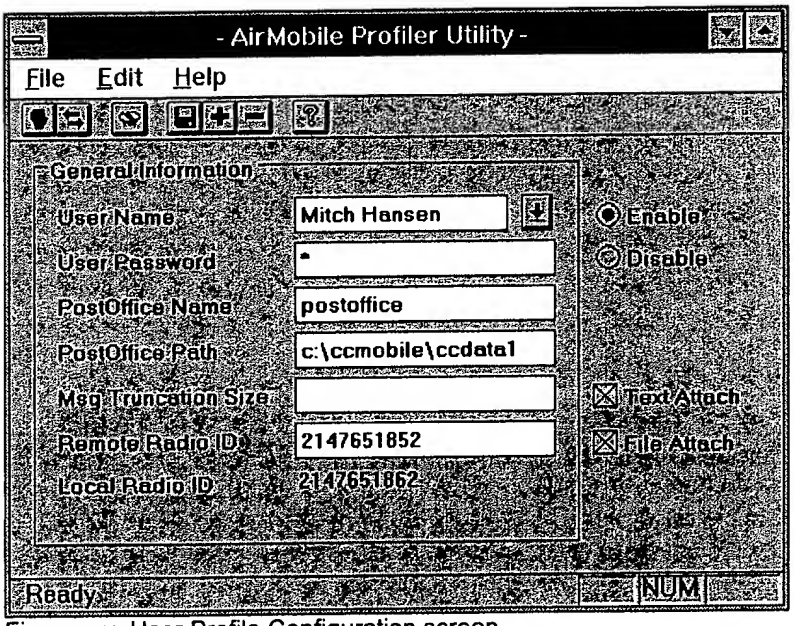



Figure x-x: User Profile Configuration screen.